



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,967	08/23/2001	Tim Goldstein	10007814-1	1561

7590 08/15/2006
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHANDLER, SARA M

ART UNIT	PAPER NUMBER
----------	--------------

3693

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/935,967	GOLDSTEIN ET AL.	
	Examiner	Art Unit	
	Sara Chandler	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/15/03, 8/23/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 6 is rejected under 35 U.S.C. 101 because it not concrete.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin, US Pat. No. 5,883,810 in view of Conquest, US Pub. No. 2003/0004737.

Re Claim 1: Franklin discloses a method for facilitating electronic commerce, comprising the step of providing an account number that is associated with a unique identifier for enabling a commercial transaction (Franklin, abstract, Fig. 4; col. 3, lines 5-

Art Unit: 3693

55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42)..

Franklin fails to explicitly disclose a product, and wherein the account number is associated with a unique identifier of the product.

Conquest discloses a product, and wherein the account number is associated with a unique identifier of the product (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050] e.g., UPC code; RFID tag).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin by adopting the teachings of Conquest to provide a method for facilitating electronic commerce using a product, comprising the step of providing an account number that is associated with a unique identifier of the product for enabling a commercial transaction.

One would have been motivated to identify users of the account and/or product; check to authorization users may have to use the account and/or product; make commercial transactions easier and more secure.

Re Claim 2: Franklin fails to explicitly disclose a method wherein said account number is provided in response to a request comprising the product identifier. Conquest discloses a method wherein said account number is provided in response to a request comprising the product identifier (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050] e.g., UPC code; RFID tag). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin by adopting the teachings of Conquest to provide a method wherein said account number

Art Unit: 3693

is provided in response to a request comprising the product identifier. One would have been motivated to identify users of the account and/or product; check to authorization users may have to use the account and/or product; make commercial transactions easier and more secure.

Re Claim 3: Franklin fails to explicitly disclose a method, wherein said account number is provided by a merchant. Official Notice is taken that it is old and well-known to have an account number that is provided by a merchant. For example, store cards for use with specific stores, organizations etc. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin to provide a method, wherein said account number is provided by a merchant. One would have been motivated to make the method easier and more convenient to use by the parties involved in the transactions.

Re Claim 4: Franklin discloses a method, wherein said account number is provided by an issuing bank (Franklin, abstract, Fig. 4; col. 3, lines 5-55; col. 4, line 48+-col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42).

Re Claim 5: Franklin fails to explicitly disclose a method further comprising the step of associating contact information with the product identifier. Conquest discloses a method further comprising the step of associating contact information with the product identifier (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050] e.g., UPC code; RFID tag). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin by adopting the teachings of Conquest to provide a method further comprising the step of associating contact

information with the product identifier. One would have been motivated to identify users of the account and/or product; check to authorization users may have to use the account and/or product; make commercial transactions easier and more secure.

Re Claim 6: Franklin discloses an apparatus for facilitating electronic commerce, comprising:

a computing unit for providing an account number that is associated with the identifier for enabling a commercial transaction (Franklin, abstract, Figs. 1-5; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42).

Franklin fails to explicitly disclose an apparatus comprising:

a product having an identifier; and

providing an account number that is associated with the product identifier.

Conquest discloses an apparatus comprising:

a product having an identifier (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050] e.g., UPC code; RFID tag); and
providing an account number that is associated with the product identifier (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin by adopting the teachings of Conquest to provide an apparatus for facilitating electronic commerce, comprising: a product having an identifier; and a computing unit for providing an account number that is associated with the product identifier for enabling a commercial transaction.

One would have been motivated to identify users of the account and/or product; check to authorization users may have to use the account and/or product; make commercial transactions easier and more secure.

Re Claim 7: Franklin discloses an apparatus, wherein said computing unit further comprises a merchant computing unit (Franklin, abstract, Figs. 1-5; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42).

Re Claim 8: Franklin discloses an apparatus, wherein said computing unit further comprises an issuing bank computing unit (Franklin, abstract, Figs. 1-5; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42).

Re Claim 9: Franklin fails to explicitly disclose an apparatus further comprising another computing unit for associating contact information with the identifier. Conquest discloses an apparatus, further comprising another computing unit for associating contact information with the identifier (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin by adopting the teachings of Conquest to provide an apparatus, further comprising another computing unit for associating contact information with the identifier. One would have been motivated to identify users of the account and/or product; check to authorization users may have to use the account and/or product; make commercial transactions easier and more secure.

Art Unit: 3693

Re Claim 10: Franklin discloses data file embodied in a computer-readable medium, comprising: an identifier segment comprising information corresponding to a representation of a product identifier (Franklin, abstract, Figs. 1-5; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42); and an account number segment comprising information corresponding to a representation of an account number for enabling a commercial transaction (Franklin, abstract, Figs. 1-5; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42).

Franklin fails to explicitly disclose a data file wherein the identifier segment comprises information corresponding to a representation of a product identifier

Conquest discloses a data file wherein the identifier segment comprises information corresponding to a representation of a product identifier (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050] e.g., UPC code; RFID tag).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin by adopting the teachings of Conquest to provide a data file embodied in a computer-readable medium, comprising: an identifier segment comprising information corresponding to a representation of a product identifier; and an account number segment comprising information corresponding to a representation of an account number for enabling a commercial transaction.

One would have been motivated to identify users of the account and/or product; check to authorization users may have to use the account and/or product; make commercial transactions easier and more secure.

Art Unit: 3693

Re Claim 11: Franklin discloses a data file, wherein the computer-readable medium resides in a merchant computing unit (Franklin, abstract, Figs. 1-5; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42).

Re Claim 12: Franklin discloses a data file, wherein the computer-readable medium resides in an issuing bank computing unit (Franklin, abstract, Figs. 1-5; col. 3, lines 5-55; col. 4, line 48+- col. 5, line 22; col. 6, lines 1-32; col. 7, lines 39-53; col. 8, lines 57-42).

Re Claim 13: Franklin fails to explicitly disclose a data file, further comprising a contact segment comprising information corresponding to digital representation of contact information for the account number. Conquest discloses a data file, further comprising a contact segment comprising information corresponding to digital representation of contact information for the account number (Conquest, abstract; [0006] [0008] [0020] [0023] [0025] [0041] [0049] [0050]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Franklin by adopting the teachings of Conquest to provide a data file, further comprising a contact segment comprising information corresponding to digital representation of contact information for the account number. One would have been motivated to identify users of the account and/or product; check to authorization users may have to use the account and/or product; make commercial transactions easier and more secure.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



ELLA COLBERT
PRIMARY EXAMINER